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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,567	12/22/2003	Allan T. Koshio	279.662US1	5068

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH
1600 TCF TOWER
121 SOUTH EIGHT STREET
MINNEAPOLIS, MN 55402

EXAMINER

FAULCON JR, LENWOOD

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/743,567	Applicant(s) KOSHIOL ET AL.	
	Examiner Lenwood Faulcon, Jr.	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Page 8 lines 12-24, Page 9 lines 1-3, filed October 17, 2005, with respect to the rejection(s) of claim(s) 1-11, 13-24, and 26-31 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Goedeke (U.S. Patent No. 5,904,708).

With respect to claims 12 and 25, Examiner takes the position that the Owen et al. reference by preferring techniques that result in lossless compression, does not teach away from reducing the sampling rate to compress data. Further, the techniques that result in lossless compression, do not necessarily teach of reducing the rate below that Nyquist rate.

2. In response to applicant's argument that there is a lack of motivation for combining the references of Amely-Velez and Bocek et al. with the teachings of Owen et al., the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner takes the position that the motivation to combine data compression techniques of Owen et al. with the systems of Amely-Velez and Bocek et al. is found in

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the Owen et al. reference, in that it is desirable to reduce the required amount of memory space (col. 22 lines 38-42). Likewise, the motivation to combine the networking capabilities of Owen et al. with the systems of Amely-Velez and Bocek et al. also may be found in the Owen et al. reference (col. 39 lines 9-19).

Claim Rejections - 35 USC § 103

3. Claims 1-10, 16-23 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amely-Velez (U.S. 2002/0107550) in view of Bocek et al. (U.S. Patent No. 5,578,063) as applied in the previous Office Action of July 12, 2005, and further in view of Goedeke (U.S. Patent No. 5,904,708).

Goedeke teaches of a system and method for deriving relative physiological signals, comprising a real time clock (col. 6 lines 64-67) and the use of a date and time event marker that is stored with a relative physiological data set, in which the data set is retained for later telemetry out to an external programmer (col. 14 lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Amely-Velez and Bocek for the reasons stated in the previous Office Action of July 12, 2005, and to further combine those teachings with the teachings of Goedeke. Amely-Velez, Bocek et al. and Goedeke all teach of implantable devices that communicate to an external device by telemetry and thus teach of analogous arts. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system Amely-Velez by including a date and time even marker, for the purpose of providing a detailed marker with the corresponding time of the event to the physician or student examining the data as

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taught by Goedeke (col. 14 lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Amely-Velez, Bocek et al. and Goedeke to have the limitations of claims 1-10, 16-23 and 28-31.

4. Claims 11-15 and 24-27 rejected under 35 U.S.C. 103(a) as being unpatentable over Amely-Velez (U.S. 2002/0107550) in view of Bocek et al. (U.S. Patent No. 5,578,063) and Owen et al. (U.S. Patent No. 6,427,083) as applied in the previous Office Action of July 12, 2005, and further in view of Goedeke (U.S. Patent No. 5,904,708) as applied to claims 1-10, 16-23 and 28-31 above.

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings Amely-Velez, Bocek et al., Owen et al. for the reasons stated in the previous Office Action of July 12, 2005, and further combine those teachings with the teachings of Goedeke. Amely-Velez, Bocek et al., Owen et al. and Goedeke all teach of medical devices that sense and acquire data that is transmitted to another device, and thus teach of analogous arts. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system as taught by Amely-Velez by including a date and time even marker, for the purpose of providing a detailed marker with the corresponding time of the event to the physician or student examining the data as taught by Goedeke (col. 14 lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Amely-Velez, Bocek et al., Owen et al. and Goedeke to have the limitations of claims 11-15 and 24-27.

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wilson et al. (U.S. Patent No. 5,908,392), Amely-Velez (U.S. Patent No. 6,400,985), Shankar et al. (U.S. Patent No. 6,442,428), Poore et al. (U.S. Patent No. 6,625,488), Amely-Velez (U.S. Patent No. 6,636,765).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenwood Faulcon, Jr. whose telephone number is 571-272-6090. The examiner can normally be reached on Monday-Thursday from 9 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lenwood Faulcon, Jr.


George Manuel

Primary Examiner